REMARKS

Claims 22-30 are pending in this application. Claims 22-27 and 30 were allowed. Claims 28-29 have been rejected under 35 USC §103(a). No claims have been amended in this reply.

Allowed Claims

Applicants respectfully thank the Examiner for allowing claims 22-27 and 30 in the last office action.

Finality of Office Action Inappropriate

The Office has marked the status of the office action as being "FINAL". Applicants believe that this is incorrect and the finality of the office action is believe to be inappropriate. The MPEP at §706.07(a) states that

> "Under present practice, second or any subsequent actions on the merits shall be final, except where the examiner introduces a new ground of rejection that is neither necessitated by the applicant's amendment of the claims nor based on information submitted in an information disclosure statement filed during the period set forth in 37 CFR 1.97(c) with the fee set forth in 37 CFR 1.17(p).

See also MPEP §609(III)(B)(2)(a)(i) & (ii).

The finality of the office action is inappropriate because the Office introduced a new ground of rejection that was not based on information submitted in an information disclosure statement. The Office uses U.S. Patent No. 5,656,812 to Takahashi (hereinafter "Takahashi") and U.S. Patent No. 6,251,516 to Bonner et al (hereinafter "Bonner") in making its rejections in the present office action. Both Takahashi and Bonner believed to have ***not been previously cited by the Office or by the applicants in an information disclosure statement***. Even though applicants have previously amended claim 28, a new ground of rejection is based on material that was not submitted in an information disclosure statement or previously cited by the Office. The

Office apparently conducted an additional search and uncovered Takahashi and Bonner and used them to reject claims 28 and 29. For these reasons, applicants respectfully request withdrawal of the finality of the office action.

Rejections under 35 U.S.C. §103(a)

Claims 28 and 29 were rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 6,251,516 issued to Bonner et al. (hereinafter "Bonner") in view of Takahashi. Applicants traverse this rejection.

The Bonner Reference

The Bonner reference was filed on February 4, 1998. Applicants' application was filed on August 3, 2003 but claims priority to U.S. Application Serial No. 09/121,677 which was filed on July 23, 1998 which in turn claims priority to U.S. Application Serial No. 09/018,452 which was filed on February 4, 1998 which is the same day as the filing date of the Bonner reference. However, applicants's application further claims priority to two provisional patent applications (60/037,864 filed on February 7, 1997 and 60/060,731 filed on October 1, 1997). The joystick subject matter, in particular, can be found in applicants' provisional patent application Serial No. 60/060,731 filed on October 1, 1997. This provisional patent application predates the Bonner filing date of February 4, 1998.

If the Bonner reference is to serve as prior art under 37 CFR 102(e), then Bonner's parent application, namely Patent No. 5,843,657 (hereinafter "the '657 Patent") should contain the same disclosure related to the joystick that is used to reject applicants' current claims in the current office action. However, Bonner's parent application, the '657 Patent does not. Bonner is a ***continuation-in-part*** of its parent and does not include the same subject matter as the '657 Patent. In particular, the '657 Patent does not include subject matter related to the joystick used by the Office in making its rejections. Bonner's parent, the '657 Patent, does not even contain FIGs. 9 and 10 of Bonner. More importantly, the '657 Patent does not contain the portion of the

specification (Bonner, col. 11, lines 10-26) that describes movement of the sample. This material was obviously added as new matter in Bonner's continuation-in-part application and can only be afforded priority back to the filing date of Bonner for the relevant subject matter used in rejecting applicants' claims 28 and 29 in the current office action. Therefore, applicants believe that Bonner should be withdrawn as a reference or a new reference that constitutes proper prior art should be provided by the Office and citations made thereto.

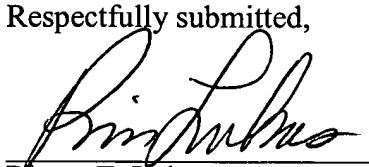
Argument

In addition to the reason that Bonner does not constitute proper prior art because subject matter in Bonner that was cited by the Office in making the rejections under 37 CFR §103(a) does not predate applicants' priority claim, applicants also traverse this rejection on the grounds that a prima facie case of obviousness is not established. To establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference must teach or suggest all the claim limitations. MPEP §2143.

Because the Bonner reference is not proper prior art, a prima facie case of obviousness is not established because Takahashi alone does not teach or suggest all of the claim limitations. In particular, Takahashi at least does not teach or suggest a laser microdissection instrument. Also, Takahashi does not contain motivation or suggestion to modify the reference to include a laser microdissection instrument. For these reasons, the rejection under §103(a) should be withdrawn.

If it is determined that a telephone conversation will expedite prosecution of this application, the Examiner is requested to telephone the undersigned at the number given below. In the unlikely event that the transmittal letter is separated from this document and the Patent Office determines that an extension and/or other relief is required, applicants petition for any required relief including extensions of time.

Respectfully submitted,

Dated: February 4, 2005 By: 

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